

Seth L. Berman, Esq. (SB-7011)
Nixon Peabody LLP
50 Jericho Quadrangle, Suite 300
Jericho, New York 11753
Phone: 516-832-7566

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF NEW YORK

CONVERSE, INC.,

Plaintiff,

- against -

H & M HENNES & MAURTIZ L.P.,

Defendant.

Civil Action No.

1:14-cv-05985
(ENV)(MDG)

**H & M HENNES & MAURTIZ L.P.'s UNOPPOSED MOTION FOR, AND
MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT OF, STAY OF ALL
PROCEEDINGS**

I. INTRODUCTION AND ISSUE TO BE DECIDED

Defendant H & M Hennes & Maurtiz L.P. ("H & M") moves, pursuant 28 U.S.C. § 1659(a), for a stay of all proceedings in this case before the Court pending conclusion of an investigation of the U.S. International Trade Commission ("ITC") involving the same issues. A stay is warranted because Plaintiff Converse, Inc. alleges infringement of the same trademark in this civil action and the ITC proceedings. H & M makes this request within the time allotted by § 1659(a). Plaintiff does not oppose this motion.

II. STATEMENT OF FACTS

On October 14, 2014, Plaintiff filed this action against H & M alleging, *inter alia*, the infringement of U.S. Trademark Registration No. 4,398,753 (the "Asserted Trademark"). On November 17, 2014 the ITC instituted Investigation No. 337-TA-936 ("ITC Action") entitled, *In*

the Matter of Certain Footwear Products, against H & M concerning the Asserted Trademark.¹

The Notice of Institution of Investigation was published in the Federal Register on November 17, 2014.²

III. LEGAL AUTHORITY

Upon the request of any party to a civil action who is also a respondent in an ITC investigation involving the parties in the civil action, the Court “shall stay, until the determination of the Commission becomes final, proceedings in the civil action with respect to any claim that involves the same issues involved in the proceeding before the Commission.” 28 U.S.C. § 1659(a). This stay is mandatory and must be granted if made within thirty days from the later of: (1) the party being named a respondent in a proceeding before the ITC, or (2) the filing of the district court action. 28 U.S.C. § 1659(a)(1), (2); *In re Princo*, 478 F.3d 1345, 1355 (Fed. Cir. 2007) (writ of mandamus directing stay of proceedings pursuant to 28 U.S.C. § 1659(a) until the ITC proceeding became final, *i.e.*, “no longer subject to judicial review”).

IV. A STAY OF ALL PROCEEDINGS IN THIS COURT IS MANDATORY AND UNOPPOSED

H & M is also named as a respondent in the ITC Action. Plaintiff alleges infringement of the Asserted Trademark in both the ITC Action and this civil action, and thus the issues in the two actions are the same. On November 17, 2014, the ITC Action commenced with the publication of the Notice of Institution of Investigation in the Federal Register, which named H & M as respondent in the investigation. This motion has been filed within thirty days of H & M being named as respondents in the ITC Action. Accordingly, H & M has met the requirements of 28 U.S.C. § 1659(a), and a stay of all proceedings is warranted.

¹ http://www.usitc.gov/press_room/news_release/2014/er1112mm3.htm

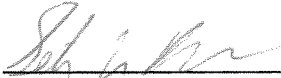
² <https://www.federalregister.gov/articles/2014/11/17/2014-27112/certain-footwear-products-institution-of-investigation-pursuant-to-19-usc-1337>

V. CONCLUSION

For the foregoing reasons, H & M respectfully requests that the Court stay this action under 28 U.S.C. § 1659(a). A proposed Order granting this Motion is submitted herewith for the Court's convenience.

Dated: December 12, 2014

Respectfully submitted,


Seth L. Berman (SB-7011)

NIXON PEABODY LLP
sberman@nixonpeabody.com
50 Jericho Quadrangle, Suite 300
Jericho, New York, 11753
Phone: (516) 832-7500

Staci Jennifer Riordan (*pro hac vice*
to be requested)
sriordan@nixonpeabody.com
Gas Company Tower
555 West Fifth St., 46th Floor
Los Angeles, CA 90013-1010
Phone: (213) 629-6000

*Attorneys for H & M Hennes &
Maurtiz L.P.*